



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/805,025

03/12/2001

Kazunori Satoh

P/647-139

1576

32172

7590

04/12/2005

DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP
1177 AVENUE OF THE AMERICAS (6TH AVENUE)
41 ST FL.
NEW YORK, NY 10036-2714

EXAMINER

WILSON, ROBERT W

ART UNIT

PAPER NUMBER

2661

DATE MAILED: 04/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/805,025	Applicant(s) SATOH, KAZUNORI	
	Examiner Robert W Wilson	Art Unit 2661	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date 242/02 9/24/02
- 4) ☐ Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 2661

Claim Rejections - 35 USC § 103

1.0 The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2.0 Claims 1-7 & 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dent (U.S. Patent No.: 6,098,878).

Referring to claim 1, Dent teaches: Figs 5-6 which are a packet communication charge pre-notification system.

A first radio telephone per Figs 5-6 (mobile) which is wirelessly connected (col. 4 line 18) to an inherent network. (mobile station)

A first radio telephone per Figs 5-6 (mobile) sends packets (col. 4 lines 9-21) (packet communication)

A second radio telephone per Figs 5-6 (terminal) is connected to the first radio telephone per Figs 5-6 (mobile). The radio telephones are able to count packets per col. 4 lines 15-17 so they are able to transmit packets (terminal)

The first radio telephone per Figs 5-6 (mobile station) which has a control processor (10 per Fig 5) which can send packets (col. 4 lines 17-17) (control means) and can count packets per col. 4 lines 9-21 (counting means) and a Display (90 per Fig 5) which can display when the cost of packet usage is greater than a threshold per col. 6 line 34-col 8 line 4.

Dent does not expressly call for: displaying the cost of the communication charge before transmitting but teaches displaying the cost of the communication charge if it exceeds a threshold.

It would have been obvious to one of ordinary skill in the art at the time of the invention to display the cost of the total communication charge and not just if the cost exceeds a threshold in order for the subscriber could travel between different tariff regions and send the packet message out in a region where the tariff cost for sending message is the least.

In Addition Dent teaches:

Art Unit: 2661

Regarding claim 2, A control processor (10 per Fig 50) calculates \$ per col. 6 lines 61 (charge calculation means)

Display (90 per Fig 5) displays \$ per col. 6 lines 54-67 (display means)

Regarding claim 3, Memory (40 per Fig 5) stores tariff (first charge table) per unit per Figs 2-4 (memory). The control processor (10 per Fig 5) calculates the charge based upon tariff tables per Figs 2-4 (calculation means)

Regarding claim 4, the transceiver (20 per Fig 5) has the ability to transmit the counted number of packets per col. 4 lines 15 (transmission means). The display (90 per Fig 5) displays \$ per col. 6 line 61 (display means).

The examiner takes official notice that central billing is well known in the art at the time of the invention.

It would have been obvious to one of ordinary skill in the art at the time of the invention to send the count of the number of packets from the wireless mobile to a central billing system so that the mobile terminal does not have to store the tariff in a table for each geographic area thereby utilizing less memory in the mobile station.

Regarding claim 5, Memory (40 per Fig 5) stores tariff unit (charge table) per Figs 2-4 (memory means). The control processor (10 per Fig 5) calculates the charge based upon tariff tables (charge tables) per Figs 2-4 and calculates per col. 4 lines 9-21.

Regarding claim 6, the terminal (Fig 5) counts per col. 4 lines 15-16 and calculates \$ per col. 6 line 61.

Regarding claim 7, Dent teaches: the system of claim 1 and control processor (10 per Fig 5) & display (90 per Fig 5) displays \$ per col. 6 lines 54-67.

Dent does not expressly call for: transmission permission but teaches displaying the cost of the communication charge if it exceeds a threshold.

It would have been obvious to one of ordinary skill in the art at the time of the invention to display the cost of the total communication charge before transmission permission is granted so that the subscriber can roam around to the least cost region and then send the transmission.

Regarding claim 9, memory (40 per Fig 5) (memory means); control processor (10 per Fig 5) (calculation unit); and display (90 per Fig 5) (display means)

The primary reference teaches calculation of cost based upon minute usage and cost of packet counts per col. col. 4 lines 9-21 which varies based upon tariffs shown per Figs 2-4. It would have been obvious to one of ordinary skill in the art at the time of the invention to display the

Art Unit: 2661

aggregate cost of services of both circuit switched (minute usage cost) and packet message costs in order for the subscriber to know the total costs of services while roaming.

Regarding Claim 10, Dent teaches: a system of Claim 1,

Dent does not expressly call for: input means for allowing the user to input transmission but teaches keypad (60 per Fig 5).

It would have been obvious to one of ordinary skill in the art at the time of the invention to utilize the keypad before transmitting the message in order for the subscriber could travel between different tariff regions and send the packet message out in a region where the tariff cost for sending message is the least.

Referring to claim 11, Dent teaches: Figs 5-6 which are a packet communication charge pre-notification system

A first radio telephone per Figs 5-6 (mobile station) which is wirelessly connected per col. 4 line 18 to an inherent network. (mobile station)

A wireless telephone per col. 4 line 18 with inherent network which utilizes packets or frames per col. 4 lines 9-21 (packet network)

A second wireless telephone which is inherently connected to a network that sends packets per col. 4 lines 9-21 which is shown per Figs 5-6 (terminal)

A control processor (10 per Fig 5) which can send packets per col. 4 lines 9-21 and can count packets per col. 4 lines 9-21 (control means and counting means)

A memory (40 per Fig 5) which stores tariff tables per Figs 2-4 (memory means)

A control processor (10 per Fig 5) which calculates charges based upon tariff per Figs 2-4 (calculation means)

A display (90 per Fig 5) which can display when the cost of packet usage is greater than a threshold per col. 6 line 34-col 8 line 4.

Dent does not expressly call for: displaying the cost of the communication charge before transmitting but teaches displaying the cost of the communication charge if it exceeds a threshold.

It would have been obvious to one of ordinary skill in the art at the time of the invention to display the cost of the total communication charge and not just if the cost exceeds a threshold in order for the subscriber could travel between different tariff regions and send the packet message out in a region where the tariff cost for sending message is the least.

Claim Rejections - 35 USC § 112

2.0 The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3.0 Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Referring to claim 8, it is not clear whether the counting means and displaying means in the sending terminal receives verification that the packets have been sent by the terminal and received by another terminal then displays the charges before transmission and the charges after transmission or the aggregate of charges for both transmission or reception.

Claim Rejections - 35 USC § 112

4.0 The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5.0 Claim 9 is rejected because the specification contains inadequate written description.

Referring to claim 9, the applicant does not explain how charges for circuit switched services can be calculated on a pre-charge basis. Circuit switched services are based upon usage. How can pre-charges for circuit switched services be calculated before they are used? How can the pre-charge for circuit switched usage minutes be combined with pre-charge costs for packet in order to determine a cumulative cost if the costs associated with usage is not known before it is used?

Response to Amendment

6.0 Applicant's arguments with respect to claims 1-11 have been considered but are moot in view of the new ground(s) of rejection. Please refer to the above rejection for details.

Art Unit: 2661

Conclusion

7.0 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert W Wilson whose telephone number is 571/272-3075. The examiner can normally be reached on M-F (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chau T. Nguyen can be reached on 571/272-3126. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Robert W Wilson
Examiner
Art Unit 2661

RWW
3/21/05



PHIRIN SAM
PRIMARY EXAMINER